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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,446	01/02/2002	Lee E. Cannon	29757/AG75/US	4837

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06/30/2005

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EXAMINER

COBURN, CORBETT B

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,446

Applicant(s)

CANNON, LEE E.

Examiner

Corbett B. Coburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claim 1-17 in the reply filed on 24 November 2003 is acknowledged.

Drawings

2. The drawings are objected to because of the issues noted on the attached Notice of Draftsperson's Patent Drawing Review. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Level of Ordinary Skill In the Art

3. The gaming or slot machine art is old and established – the art has been practiced for over 100 years. (See Fey, *Slot Machines, A Pictorial History of the First 100 Years*, Bettini, US Patent Number 497,906 and Schultze, US Patent Numbers 502,891 & 514,664.) Bonus games have been practiced in the art for most of that century. (E.g., Mills 1937 Bonus Bell, Fey page 126.) Bonus games are well known to attract players because they provide a chance at additional payouts and they add to player excitement.

4. Games requiring at least some level of player skill have been an integral part of the art since the beginning. (See Clawson, US Patent Number 517,436, and the Fey 1924 3 Jacks, Fey page 78.) Skill games are popular with players because they believe that they have control over the outcome. Skill games are also legal in some jurisdictions that outlaw pure chance devices. This has led to such games as the skill stop slot machine (e.g., 1934 Dixie Bell, Fey page 164 and Joze, US Patent Number 2,135,182) and skill bonus games (e.g., Hoke, US Patent Number 2,102,532).

5. Bonus games incorporating other well-known games have also been known for over 70 years. Mills (US Patent Number Re. 19,674) incorporates the game of baseball as a theme for the bonus game. This is hardly surprising since one of the earliest examples of the art (Neely et al., US Patent Number 617,297) used baseball as an underlying theme. This type of game is well known to attract players who like the game or sport depicted.

6. Nor is baseball the only game implemented as a bonus game. There are bonus games implementing such games as Monopoly (DeMar et al., US Patent Number 6,315,660), Scrabble (Anderson et al., US Patent Number 6,428,412), Battleship (Weiss, US Patent Number

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6,309,299), chess, checkers, bingo, and tic-tac-toe (Webb et al., US Patent Number 6,461,241) to name but a few.

7. Clearly, the art suggests to anyone of ordinary skill that bonus games are desirable. Furthermore, bonus games that embody a sport or board game are so well known (and so profitable) to suggest to one of ordinary skill to look to other sports or board games as a source for bonus games.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1 & 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Webb et al. (US Patent Number 6,461,241).

Claim 1: Webb teaches a gaming system, comprising: a primary game (slot machine game) and a secondary game of mental strategy (grid alignment games, tic-tac-toe, chess, checkers, Col 2, 1-13), in which a gamer takes a plurality of turns, each turn of said secondary game being awarded upon the occurrence of at least one of a predetermined event in said primary game and a particular result during play of said primary game. (Col 2, 21-40)

Claim 2: The secondary game comprises a matrix (or grid) type game. (Col 2, 23-25)

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webb as applied to claim 2 in view of Pente.

Overall discussion: Webb teaches the invention substantially as claimed but does not teach that the bonus game is Pente. Webb suggests that the bonus game may be a grid game that requires a player to align a predetermined number of markers on a grid pattern. This is the basic premise of the game of Pente. Furthermore, Webb teaches that the bonus game may be a strategy game such as tic-tac-toe, checkers, or chess. But Webb does not actually describe the rules of the alignment game. As pointed out above, it is well known in the art to look to other popular games for implementation as a bonus game. These games are known to add interest to the game and thus to attract players. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Webb to implement Pente as a bonus game in order to add interest to the game and thus to attract players.

Claims 3-8, 13 & 14: Pente is matrix type game, upon positioning at least two first game pieces along a line including at least one second game piece, the gamer captures at least said at least one second game piece. Upon said positioning, the gamer may also capture said at least two first game pieces. At least one second game piece is captured when said

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at least two first game pieces are positioned adjacent to and at opposite ends of a single second game piece or a sequence of linearly arranged second game pieces. At least one second game piece is captured when at least three first game pieces are positioned in-line with said at least one second game piece. Upon being captured, said at least one second game piece is removed from said matrix. Upon being captured, said at least one second game piece becomes a first game piece (i.e., it can be captured by the other player). By skillful positioning said at least two first game pieces, the gamer may prevent capturing of said at least one-second game piece. By skillful positioning at least one additional first game piece along said line, the gamer may recapture at least each second game piece located along said line. See Pente Rules for overview of the game.

Claims 9, 10: Webb teaches a fixed payout whenever a player places a marker on the grid. (Col 2, 40-42) This is equivalent to providing an award whenever the gamer captures a piece.

Claim 11: While Webb does not disclose the amount of the payout, setting the award value is fundamental to maintaining profitability. No one of ordinary skill in the art could remain in business long if they did not know how to choose a payout level to maintain profitability. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Webb to have the award associated with each game piece be an amount that has been wagered on that game piece in order to maintain the desired level of profitability.

Claim 12: While Webb does not disclose the amount of the payout, setting the award value is fundamental to maintaining profitability. No one of ordinary skill in the art

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could remain in business long if they did not know how to choose a payout level to maintain profitability. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Webb to have the award associated with each game piece be based on a result in said primary game that resulted in placement of that game piece in order to maintain the desired level of profitability.

Claim 15: While Webb does not disclose the amount of the payout, setting the award value is fundamental to maintaining profitability. No one of ordinary skill in the art could remain in business long if they did not know how to choose a payout level to maintain profitability. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Webb to have provided the gamer with an award for each captured game piece and an additional award for previously preventing capture of said at least one second game piece upon recapturing at least each second game piece located along said line in order to maintain the desired level of profitability.

Allowable Subject Matter

12. Claims 16 & 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

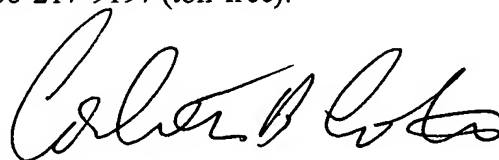
13. The following is a statement of reasons for the indication of allowable subject matter: A thorough search of the prior art fails to disclose any reference or references, which, taken alone or in combination, teach or suggest, in combination with the other limitations, the gamer is permitted to prevent other gamers from taking turns for a specified period of time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Corbett B. Coburn
Examiner
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